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EXAMINER ORR, HENRY W				
ART UNIT 2176		PAPER NUMBER		
NOTIFICATION DATE 11/26/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/761,314

Applicant(s)

MONDRY ET AL.

Examiner

Henry Orr

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/2008 has been entered.

DETAILED ACTION

1. This action is responsive to applicant's amendment dated 8/25/2008.
2. Claims 1-20 are pending in the case.
3. Claims 1 and 11 are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3-11 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM TDB, "Visual for Multiple-Icon Drag Movement" (hereinafter "IBM Drag"), original publication September 1, 1994 in view of IBM**

TDB, "Adding and Removing Icons from a Multi-Icon" (hereinafter "IBM Multi-Icon"), original publication March 1, 1993 of record.

Claim 1:

IBM Drag anticipates **detecting user action of dragging at least two objects from another application or a source of draggable objects in the application over said display using said input device, said at least two objects forming a list of attached objects, and entering a dropping mode;** (see p. 417 1st par., Figure 1)

IBM Drag anticipates **while at least one of said at least two objects remains undropped, continuing to execute the following actions:**

a) displaying a visual representation of each of said objects proximal to a current position of said cursor, as a set of icons, (see p. 418 1st par., Figure 3)

IBM Drag fails to expressly teach the dropping steps as recited in independent claim 1.

However, IBM Multi-Icon anticipates **b) when the user's intention to drop an object is detected, executing the following actions:**

b1) processing dropping of a first object in said list of attached objects into said surface at a position dictated by the current position of said cursor,

b2) removing the visual representation of said dropped object from said set of icons and

b3) removing said dropped object from said list of attached objects;

c) performing steps b1), b2) and b3) for each object to be dropped, so that each of said at least two objects can be sequentially dropped at unique locations independently of other objects in said list of attached objects; and exiting said mode when the list of attached objects is empty (see p. 401 3rd par.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Multiple-Icon as taught by IBM Drag to include the dropping steps as taught by IBM Multi-Icon to provide the benefit of a new technique of removing icons to compliment existing direct manipulation techniques (see IBM Multi-Icon; p. 401 last par.)

Claim 3:

IBM Drag anticipates **wherein the set of icons are further arranged in a regular row extending from the right of the cursor position and sorted by selection order with the icon representing the next object to be dropped being at a left-most position of said row** (see p. 417, Figures 1 and 2).

Claim 4:

IBM Drag anticipates **wherein the set of icons are further arranged in a regular column extending down from the cursor position and sorted by selection order with the icon representing the next object to be dropped being located at a top-most position of said column** (see p. 417, Figures 1 and 2). Examiner interprets

IBM Drag's Figure 1 to be capable of illustrating icons arranged in a column format along with the row format currently shown.

Claim 5:

IBM Drag anticipates **wherein the set of icons representing the dragged objects is further limited to a maximum predetermined number of objects remaining** (see p. 418 1st par., Figures 3 and 4).

Claim 6:

IBM Drag anticipates **wherein when the number of objects in the list of attached objects exceeds said maximum predetermined number of objects, a final object in the set of icons representing the dragged objects is further modified to indicate that additional objects remain to be dropped beyond those that are visible in the attached set of icons, the method comprising one of: appending an icon indicating the presence of additional but unseen icons** (see p. 418 1st par., Figures 3 and 4).

Claim 7:

IBM Drag anticipates **rolling a mouse wheel in a direction opposite the one direction or pressing another key to send the object in the last position within the set of objects attached to the cursor to the first position and refreshing the displayed list of icons** (See p. 417 last par., p. 418 1st par., Figures 2 and 3).

Claim 8:

IBM Drag anticipates **wherein an object being dropped is an image, and wherein the icon representing said image is a reduced-resolution version of said image** (see par. 417, Figure 1).

Claim 9:

IBM Drag fails to expressly teach additional objects being inserted into a list of the attached objects as recited in claim 9.

However, IBM Multi-Icon anticipates **wherein additional objects can be inserted into the list of attached objects, the method comprising moving the pointing device such that the cursor is positioned over a non-dragged object to be added to the list of attached objects, detecting the user's intention to insert said non-dragged object into the list of attached objects; and adding a representation of said added non-dragged object into the set of icons** (see p.401 3rd par.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Multiple-Icon as taught by IBM Drag to include the adding an icon to a multi-icon steps as taught by IBM Multi-Icon to provide the benefit of a new technique of adding icons to compliment existing direct manipulation techniques (see IBM Multi-Icon; p. 401 last par.).

Claim 10:

IBM Drag fails to expressly teach wherein objects can be removed from the set of icons and list of objects as recited in claim 10.

However, IBM Multi-Icon anticipates **wherein objects can be removed from the set of icons and list of objects by: signaling an intent to remove the first object; removing said first object from said set of icons; and removing said first object from said list of attached objects** (see p. 401 2nd and 3rd par.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Multiple-Icon as taught by IBM Drag to include the removing an icon from a multi-icon steps as taught by IBM Multi-Icon to provide the benefit of a new technique of removing icons to compliment existing direct manipulation techniques (see IBM Multi-Icon; p. 401 last par.).

Claims 11 and 13-20:

Claims 11 and 13-20 include a program embodied on a computer readable medium to implement the steps that are substantially encompassed in method claims 1 and 3-10 respectively; therefore the claims are rejected under the same rationale as method claims 1 and 3-10 above.

6. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM Drag in view of IBM Multi-Icon as cited above, in view of Magid et al. (hereinafter "Magid"), U.S. Patent No. 5,764,873 of record.

Claim 2:

Neither IBM Drag nor IBM Multi-Icon expressly teach a user aborting or temporarily leaving and re-entering the mode of dropping multiple objects as recited in claim 2.

However, Magid teaches escaping ("abort") and re-entering the mode of dropping multiple objects (see col. 7 lines 1-10). **(claim 2; i.e., wherein the user is additionally able to abort or temporarily leave and re-enter the mode of dropping multiple objects, said method comprising signaling an intent to temporarily exit the mode of dropping multiple objects;)**

Magid teaches doing other intermediate steps ("work") in the application (see col. 1 lines 56-58). **(claim 2; i.e., doing other work in the application)**

Magid teaches the ability to signal the intent to re-enter drag-and-drop mode to continue to interact with the drag-and-drop tool (see col. 6 lines 35-42). **(claim 2; i.e., signaling the intent to re-enter the mode of dropping multiple objects; resuming the operation of the dropping mode at step a).)**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the modes of dragging and dropping multiple objects as taught by IBM Drag in view of IBM Multi-Icon to include an escape ("abort") and re-enter

operation as taught by Magid to provide the benefit of performing intermediate steps between selecting and dropping multiple objects (see Magid col. 1 lines 55-58).

Claim 12:

Claim 12 includes a program embodied on a computer readable medium to implement the steps that are substantially encompassed in method claim 2; therefore the claim is rejected under the same rationale as method claim 2 above.

Response to Arguments

7. Applicant's arguments filed 8/25/2008 have been fully considered but they are not persuasive.

Examiner notes that the following Response to Arguments was also submitted in the Advisory action dated 9/22/2008 in which Applicant has failed to acknowledge.

Rejections Under 35 U.S.C. § 103

In respect to claims 1 and 11, Applicant argues that IBM Multi-Icon and IBM Drag fail to describe, or render obvious, either alone or in combination, the subject matter of independent claims 1 and 11. In particular, Applicant alleges that there is nothing to suggest, in either IBM Drag or IBM Multi-icon, that the multiple icons in IBM Drag should be modified to enable a user to perform a different operation on each of the icons being moved across the display screen.

Examiner notes that Applicant's claims 1 and 11 do not necessitate a different operation to occur on each of the icons while being moved across the display screen. IBM Drag is capable of dragging at least two objects wherein said two objects form a list of attached objects. Once IBM Drag drops the attached objects, Examiner relies on IBM Multi-Icon to teach entering a dropping mode with the dropped objects. Therefore, the collection of dropped objects would be the multi-icon as taught by IBM Multi-Icon. IBM Multi-Icon enters a dropping mode by bringing up the list of icons. Based on the language of the claims, it is not necessary to combine the references in the way suggested by the Applicant (i.e. a further select, drag and drop, during a drag and drop operation already being performed) in order to meet the claim invention. IBM Drag can drag and drop the attached objects. Then after the dropping as taught by IBM Drag, IBM Multi-icon teaches entering a dropping mode with the dropped collection of attached objects. Thus, IBM Drag and IBM Multi-Icon do render obvious the subject matter of independent claims 1 and 11.

Applicant argues that the claims recite that the "set of icons" is displayed at the "current position of the cursor" and the dropping of the object occurs at the "current position of the cursor."

Examiner respectfully disagrees.

Applicant claims explicitly recite "processing the dropping of a first object in said list of attached objects into said surface at a position dictated by the current position of said cursor". In other words, "a position dictated by the current position of said cursor" does not have the same scope as "at the current position of the cursor".

In respect to dependent claims 3, 4, 13 and 14, Applicant argues that neither reference describes a "next object to be dropped" based on the location of the object in a list of objects.

Examiner notes that the language of dependent claims 3, 4, 13 and 14 do not require a next object to be dropped based on the location of the object in a list of objects. The language of the claims only recites an icon at a particular position representing the next icon to be dropped. In other words, the language of the claims does not require the next object to be the **ONLY** object to be dropped from the attached objects. For example, when IBM Drag drags the attached icons, all the attached icons at every position (e.g., leftmost, top-most) drop represent the next object to be dropped because all the attached icons are dropped at the same time. Therefore, IBM Drag teaches or suggests each of the attached objects at every particular position to represent the next object to be dropped (e.g. including leftmost, top-most positions).

For at least the foregoing reasons, Examiner maintains Prior Art Rejections.

Conclusion

8. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 270 1308. The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/20/2008
HO

/Rachna S Desai/
Primary Examiner, Art Unit 2176